

REMARKS

The Official Action mailed February 4, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on September 26, 2006.

The Applicant notes the *partial* consideration of the Information Disclosure Statement filed on May 3, 2007 (received by OIPE May 7, 2007). Specifically, it appears that the Examiner inadvertently overlooked the citation of the "International Preliminary Report for PCT/JP2005/006725 dated March 1, 2007" and the "Supplementary European Search Report for PCT/JP2005/006725 dated March 29, 2007." A copy of the partially considered Form PTO-1449 is available in the Image File Wrapper under the heading, "List of References cited by applicant and considered by examiner" and has a mail room date of "02-04-2009." The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the "International Preliminary Report for PCT/JP2005/006725 dated March 1, 2007" and the "Supplementary European Search Report for PCT/JP2005/006725 dated March 29, 2007."

Claims 11-16 are pending in the present application, of which claims 11, 13 and 14 are independent. Claims 11-13 and 15 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claim 13 under 35 U.S.C. § 101 "as not falling within one of the four statutory categories of invention" (page 2, Paper No. 20090127). Specifically, the Official Action asserts that "[t]he instant claim is neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process"

(*Id.*). Also, the Official Action asserts that "steps of receiving, discriminating, determining, and reproducing ... could be completely performed mentally, verbally or without a machine nor is any transformation present" (*Id.*). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Prior to the present amendment, claim 13 recited, among other features, "receiving a wireless transmitted signal including data of identifying the group and voice data of representing voice, the data of identifying the group replacing signal voice data indicative of silence," which, contrary to the assertion in the Official Action, could not be performed mentally, verbally or without a machine.

Although claim 13 is believed to be statutory without amendment, the Applicant has amended claim 13 to recite the following:

receiving by a reception unit a wireless transmitted signal including data of identifying the group and voice data of representing voice, the data of identifying the group replacing signal voice data indicative of silence;

discriminating by a reception unit the voice data and the data of identifying the group in the received signal;

determining by a reception unit whether or not the received signal is to be reproduced, on the basis of the data of identifying the group; and

when it is determined that the received signal is to be reproduced, reproducing voice data for voice data sections and reproducing silence for sections of the data of identifying the group, by using a reproduction unit

The Applicant respectfully submits that claim 13 is positively tied to a particular machine and transforms underlying subject matter. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 are in order and respectfully requested.

Paragraph 3 of the Official Action rejects claim 11 under 35 U.S.C. § 112, second paragraph, asserting a lack of antecedent basis for "the signal to be wireless transmitted." In response, claim 11 has been amended to recite "receiving a signal which as been wirelessly transmitted." The Applicant respectfully submits that amended claim 11 particularly points out and distinctly claims the subject matter which applicant

regards as the invention and is definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 5 of the Official Action objects to claim 11 asserting that "the voice" lacks proper antecedent basis and 'data identifying of the group' should be 'data identifying the group" (page 3, Paper No. 20090127). In response, claim 11 has been amended to recite "a voice" and "data identifying of the group" has been changed to "data of identifying the group," which is consistent, for example, with claim 13.

Paragraph 6 of the Official Action objects to claim 12 asserting that "the data" lacks proper antecedent basis" (Id.). In response, claim 12 has been amended to recite "the voice data" and "the replaced data," which are positively recited in claim 11.

Paragraph 7 of the Official Action objects to claim 15 asserting that "the control means of executing processing' should be 'the control means executing processing'" (Id.). In response, claim 15 has been amended to recite that "the control means operates to execute processing."

The Applicant respectfully submits that amended claims 11, 12 and 15 are clear. Accordingly, reconsideration and withdrawal of the objections are in order and respectfully requested.

Paragraph 9 of the Official Action asserts that an unspecified portion of the specification improperly incorporates information by reference under 37 C.F.R. § 1.57. In the objection, the Official Action highlights the term "foreign application." However, it is not clear what portion of the present specification is alleged to constitute an improper incorporation by reference. Also, the Applicant notes that the present specification does not use the phrase "incorporate by reference" or the like. Accordingly, reconsideration and withdrawal of the objections are in order and respectfully requested.

Paragraph 11 of the Official Action rejects claims 11-16 as obvious based on the combination of WO 99/27745 to Johnson and U.S. Publication No. 2005/00808709 to Marks. Regarding claim 11, the Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present

application, as amended. Regarding claims 13 and 14, the Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of independent claim 11, as amended. Independent claim 11 has been amended to recite encoding the whole of an inputted analog voice signal regardless whether the signal is in an uttered section or an unuttered section to generate voice data. For the reasons provided below, Johnson and Marks, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action asserts that Johnson teaches that “whenever a voice activity detector VAD determines that voice is no longer active, a transmitter may enter DTX mode, and it ceases to transmit in every one of its assigned timeslots” (page 4, Paper

No. 20090127, citing Johnson at page 9, lines 3-15). However, the present invention is directed to a communication system in which a voice encoder always continues to encode voice regardless whether an utterance is made or not. In the present invention, voice data is continuously created regardless of whether an utterance is made or not, and thereafter it is decided whether the created voice data is silent or not. Subsequently, voice data which is indicated to be silent is replaced with (non-voice) data of identifying a group. Thus, the present invention, in which voice data is indiscriminately created regardless whether a person is speaking or silent, is essentially different from the technique of Johnson in which it is decided by a VAD whether an utterance is made or not before encoding voice data.

The Applicant respectfully submits that Marks does not cure the deficiencies in Johnson. Marks is relied upon to allegedly teach that one or more header fields in requests from a client may be replaced by a group header identifier. However, the Applicant respectfully submits that Johnson and Marks, either alone or in combination, do not teach or suggest encoding the whole of an inputted analog voice signal regardless whether the signal is in an uttered section or an unuttered section to generate voice data.

Since Johnson and Marks do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Regarding claims 11, 13 and 14, there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Johnson and Marks or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately

set forth why one of skill in the art would combine the references to achieve the features of the present invention.

Independent claim 11 recites replacing the voice data which is discriminated that it indicates silent voice with data of identifying the group. Independent claim 13 recites receiving a wireless transmitted signal including data of identifying the group and voice data of representing voice, the data of identifying the group replacing signal voice data indicative of silence. Independent claim 14 recites reception means for receiving a received signal including data of identifying the group and voice data representing voice, the data of identifying the group replacing original voice data indicative of silence.

The Official Action concedes that “JOHNSON does not expressly disclose replacing the voice data which is discriminated that it indicates silent voice with *data identifying the group*” (pages 5 and 7, Paper No. 20090127; emphasis in original). The Official Action asserts that “Marks discloses one or more header fields in requests from a client may be replaced by a group header identifier (para. 0006)” and that “it would have been obvious ... to incorporate the replacing header fields with a group header identifier as taught by Marks into the invention of JOHNSON ... to reduce overhead of the messages transmitted” (*Id.*). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Marks merely teaches that “a request header may include fields of information that define acceptable response to the requests, including the media types, character sets, content codings, sets of preferred natural languages, and byte ranges of acceptable responses” (¶ [0003]) and that “one or more header fields in requests from a client may be replaced by a group header identifier” (¶ [0006]). That is, Marks describes types of non-voice information provided in the header. Marks does not appear to teach or suggest that the header could or should contain voice data. As such, Marks merely teaches that non-voice header information may be replaced with a group header identifier, which is another type of non-voice information. However, Marks does not teach or suggest that voice data should be replaced with data of identifying the group.

Also, the Official Action has not demonstrated why one of ordinary skill in the art at the time of the present invention would have had sufficient reason to modify Marks so that a group header identifier would be used to replace voice data.

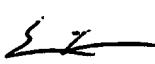
Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Johnson and Marks or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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